

## **REMARKS**

Claims 23-29, 31, 32 and 34-44 are pending in this application. All pending claims stand rejected. By way of this paper, Claims 23, 24, 28, 34-38, 42 and 43 have been amended.

The foregoing amendments and following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

### **Nonstatutory Double Patenting Rejection**

Claims 23-44 [sic.] stand rejected as being unpatentable over claims 1-21 of copending U.S. Patent Application No. 10/050,979. The provisional rejection is traversed. At the time of the office action, claims 1-23 had been cancelled from copending U.S. Patent Application No. 10/050,979. Further, Applicants point out that a terminal disclaimer has already been submitted in the present chain of applications with the amendment filed in the parent application in response to the December 15, 2005 Office Action. Applicants propose that there would have been no need for a second terminal disclaimer even had claims 1-23 not been cancelled from copending U.S. Patent Application No. 10/050,979.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 23-27, 29, 31, 32, 34-37 and 39-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reifel et al., US 7,013,288 in view of Mizumo U.S. Publication No. 2001/0021311.

Claim 23 contains several features not disclosed by the references of record. For example, claim 23 calls for allowing a user to order products using an order terminal “*associated with one of a plurality of business entities.*” The Office Action suggests that Reifel et al. teach this feature in column 3, lines 35-39, but a careful reading of that passage shows only that an image can be transferred from a camera to a computer or printer. The Examiner notes that column 5, lines 28-44 define the business relationship between the storage device providers (camera manufacturer) and the business entities (print houses). Accordingly, to meet the terms of claim 23 quoted above, the order terminal would have to be associated with one of the print houses. There is no disclosure in the references to that effect.

Claim 23 also calls for identifying the storage device provider “*by electronically reading a code stored on the portable digital storage device.*” The Examiner suggests that this feature is taught by Reifel et al. in column 12, lines 29-38. A review of that passage shows that Reifel et al. merely suggests that such information can be stored in a customer database 27 of the print house. It does not disclose how the information is obtained. However, looking at column 11, line 50 through column 12, line 17; it is clear that the consumer creates a profile with the camera vendor (i.e., the claimed service provider) to be thereafter transferred to the print house. Accordingly, the references do not disclose the claimed feature of identifying the service provider *by electronically reading a code stored on the portable digital storage device.*

Claim 23 also calls for “displaying an order screen on the order terminal *“in response to reading the code stored on the portable digital storage device.”* The Examiner cites column 5, lines 11-19 and 28-44 and column 12, line 6 against this feature, but Applicants are unable to find any mention of a display process, and certainly not a display process that operates in response to reading a code stored on a storage device.

Assuming arguendo that the references might be capable of combination, there is at least one limitation in the invention set forth in claim 23 that is not disclosed by the references individually or in combination. The claims include the limitations of using an order terminal *associated with one of a plurality of business entities*; identifying the storage device provider *by electronically reading a code stored on the portable digital storage device*; and displaying an order screen on the order terminal *“in response to reading the code stored on the portable digital storage device.* The primary reference fails to disclose these claim elements. The secondary reference fails to disclose the information undisclosed by the primary reference.

Claim 24 depend from claim 23 and is patentable therewith. Further, claim 24 calls for “*reading a second portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user.*” The Examiner cites Reifel et al.’s column 3, lines 65-67 against this

limitation, but the cited section of Reifel et al. is silent with respect to reading a digital storage device and connecting the storage device to an order terminal.

Claim 25 depends from claim 23 and is patentable therewith.

Claim 26 depends from claim 23 and is patentable therewith. Further, claim 26 calls for a particular type of order terminal. The Examiner cites Reifel et al.'s camera kiosk 20 as such an order terminal, but it is clear that kiosk 20 is used to purchase cameras and not to order services from print house 25 (the business entity).

Claims 27 and 29-32 depend from claim 23 and are patentable therewith.

Claim 34 contains features not disclosed by the references of record. For example, claim 34 calls for an order terminal "*associated with a merchant.*" The Office Action suggests that Reifel et al. teaches this feature in column 3, lines 35-39, but a careful reading of that passage shows only that an image can be transferred from a camera to a computer or printer. The Examiner notes that column 5, lines 28-44 define the business relationship between the storage device providers (camera manufacturer) and the merchant (print houses). Accordingly, to meet the terms of claim 23 quoted above, the order terminal would have to be associated with the merchant. There is no disclosure in the references to that effect.

Assuming arguendo that the references might be capable of combination, there is at least one limitation in the invention set forth in claim 23 that is not disclosed by the references individually or in combination. The claims include the limitations of using an order terminal "*associated with a merchant.*" The primary reference fails to disclose these claim elements. The secondary reference fails to disclose the information undisclosed by the primary reference.

Claims 35-37 and 39-43 depend from claim 34 and are patentable therewith.

Claim 44 sets forth a program storage device readable by machine, the storage device embodying instructions to perform the method steps of claim 23.

Claim 23 defines limitations of using an order terminal *associated with one of a plurality of business entities*; identifying the storage device provider by *electronically reading a code stored on the portable digital storage device*; and displaying an order screen on the order terminal *“in response to reading the code stored on the portable digital storage device.”* The primary reference fails to disclose these claim elements. The secondary reference fails to disclose the information undisclosed by the primary reference. It is argued that since the references of record do not show the method steps of claim 23, then the references do not show a storage device embodying instructions to perform the method steps of claim 23.

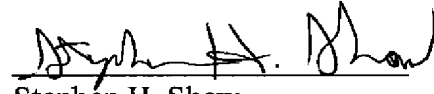
Claims 28 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Reifel et al. in view of Vittal et al. Assuming *arguendo* that the references might be capable of combination, there is at least one limitation in the invention set forth in claims 28 and 38 that is not disclosed by the references individually or in combination. Claim 28 includes the limitations of using an order terminal *associated with one of a plurality of business entities*; identifying the storage device provider by *electronically reading a code stored on the portable digital storage device*; and displaying an order screen on the order terminal *“in response to reading the code stored on the portable digital storage device.”* Claim 38 calls for an order terminal *“associated with a merchant.”* Reifel et al. fail to disclose these claim elements. Vittal et al. fail to disclose the information undisclosed by the primary reference.

### **CONCLUSION**

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen H. Shaw", is written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.